REMARKS

By this Amendment, Applicants amend claims 1, 6, 8, 13, 14, 19, 20, and 28, and

cancel claims 5 and 7 without prejudice or disclaimer of the subject matter thereof.

Claims 1, 6, 8, 10, 12-14, 16, 18-20, 22, 24, 25, 28, and 29 remain pending.

In the Office Action,[1] the Examiner rejected claims 8, 10, 12, and 13 under

35 U.S.C. § 101 as being directed to nonstatutory subject matter; and rejected claims 1,

5-8, 10, 12-14, 16, 18-20, 22, 24, 25, 28, and 29 under 35 U.S.C. § 103(a) as being

unpatentable over U.S. Publication No. 2003/0004874 to Ludwig et al. ("*Ludwig*") in

view of U.S. Publication No. 2002/0032692 to Suzuki et al. ("*Suzuki*").

I.   Rejection of Claims 8, 10, 12, and 13 under 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 8, 10, 12, and 13 under

35 U.S.C. § 101. The Examiner provides two bases for this § 101 rejection.

First, the Examiner alleges that "[t]he language of the claims raises a question as

to whether the claims . . . result in a practical application producing a concrete[,] useful,

and tangible result." Office Action, p. 2. However, *In re Bilski*, 545 F.3d 943, 959,

states that "'a useful, concrete and tangible result' . . . inquiry is insufficient to determine

whether a claim is patent-eligible under § 101." Therefore, the Examiner's first basis

(i.e., the useful-concrete-tangible test) is improper.

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[1]   The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Second, the Examiner alleges that "[t]hese claims are not statutory because a process must be tied to another statutory class." Office Action, p. 2. Applicants respectfully note that independent claim 8 recites "displaying a dialogue on a <u>display device</u>" and "an instruction table comprising . . . instructions automatically <u>executed by a computer</u>." For at least these reasons, the method of claim 8 is tied to a particular machine. Nonetheless, to advance prosecution, Applicants amend claim 8 to recite "storing, using a <u>processor</u>, an identification of the current state of the invoice." For at least this additional reason, claim 8 is directed to statutory subject matter.

In addition, dependent claims 10, 12, and 13 are also directed to statutory subject matter at least due to their dependence from independent claim 8. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 8, 10, 12, and 13 under 35 U.S.C. § 101.

II. Rejection of Claims 1, 5-8, 10, 12-14, 16, 18-20, 22, 24, 25, 28, and 29 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1, 5-8, 10, 12-14, 16, 18-20, 22, 24, 25, 28, and 29 under 35 U.S.C. § 103(a) as being unpatentable over *Ludwig* in view of *Suzuki*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." M.P.E.P. § 2141(III).

> [T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . are as follows:
> (A) [Determining the scope and content of the prior art;]

(B) Ascertaining the differences between the claimed invention and the prior art; and
(C) Resolving the level of ordinary skill in the pertinent art.

M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

A. Prior Art Fails to Teach or Suggest the State Data Field Including Four Links to Four Tables

Independent claim 1 recites a computer readable storage medium for storing an electronic data record of an invoice comprising, for example, "a state data field . . . including . . . an identification of a current state[,] . . . a first link to a description table[,] . . . a second link to an instructions table[,] . . . a third link to an event table[,] . . . and a fourth link to a proposal table."

Ludwig discloses that "[t]he system may link the status field to the invoice history page." *Ludwig*, para. 0092. *Suzuki* discloses various tables. *See, e.g., Suzuki*, Figs. 16-17. However, *Ludwig* and *Suzuki* fail to teach or suggest that the status field includes four links to four corresponding tables. Therefore, *Ludwig* and *Suzuki* fail to teach or suggest "a state data field . . . including . . . an identification of a current state[,] . . . a first link to a description table[,] . . . a second link to an instructions table[,] . . . a third link to an event table[,] . . . and a fourth link to a proposal table," as recited in claim 1.

B.   Prior Art Fails to Teach or Suggest the Four Tables Including Identifications of Possible States

Independent claim 1 further recites "a description table comprising identifications of a plurality of possible states of the invoice[,] . . . an instructions table comprising the identifications of the plurality of possible states of the invoice[,] . . . an event table comprising the identifications of the plurality of possible states of the invoice [,] . . . and . . . a proposal table comprising the identifications of the plurality of possible states of the invoice." Therefore, each of the four tables "compris[es] the identifications of the plurality of possible states."

Ludwig discloses that "the invoice history page . . . display[s] a full status history for the selected invoice." *Ludwig*, para. 0092. However, the invoice history page of *Ludwig* does not "compris[e] the identifications of the plurality of <u>possible states</u>," as recited in claim 1. Indeed, the Examiner acknowledges that "the history page . . . contains the <u>current status</u> of an invoice." Office Action, p. 5. Furthermore, *Ludwig* discloses only <u>one</u> invoice history page. *Ludwig* fails to teach or suggest the four claimed tables.

Suzuki discloses various tables. *Suzuki* further discloses "[t]he user of the workflow management system uses a process definition tool 141 to define possible states taken by process instances." *Suzuki*, para. 0060. However, *Suzuki* fails to teach or suggest any table "comprising the identifications of the plurality of <u>possible</u> states," let alone four tables "comprising identifications of the plurality of possible states," as recited in claim 1 (emphasis added).

For at least these reasons, *Ludwig* and *Suzuki* fail to teach or suggest "a description table comprising identifications of a plurality of possible states of the invoice[,] . . . an instructions table comprising the identifications of the plurality of possible states of the invoice[,] . . . an event table comprising the identifications of the plurality of possible states of the invoice [,] . . . and . . . a proposal table comprising the identifications of the plurality of possible states of the invoice," as recited in claim 1.

C.   Prior Art Fails to Teach or Suggest the Instruction Table

Independent claim 1 further recites "an instruction table comprising the identifications of the plurality of possible states and corresponding instructions automatically executed by a computer."

The Examiner acknowledges that "Ludwig . . . does not explicitly disclose[] . . . a second link to an instruction table comprising the identifications of the plurality of states and corresponding instructions automatically executable by a computer." Office Action, p. 6. However, the Examiner alleges that *Suzuki* discloses the claimed "instruction table." This is incorrect.

Suzuki discloses "a state name," "a source state name," and "a destination state name." *See, e.g., Suzuki*, paras. 0071, 0073, 0080. Even assuming that the state names in *Suzuki* could correspond to the claimed "identifications of the plurality of possible states," which Applicants do not concede, *Suzuki* fails to disclose or suggest a table including the plurality of possible state names and corresponding instructions automatically executed by a computer. Although the Examiner cites paragraphs 0019-20, 0064, 0073, 0145, and 0150 of *Suzuki* (Office Action, p. 6), these portions and other

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portions of *Suzuki* fail to disclose a single table including a plurality of state names and corresponding instructions automatically executed by a computer.

Therefore, *Ludwig* and *Suzuki* fail to teach or suggest "an instruction table comprising the identifications of the plurality of possible states and corresponding instructions automatically executed by a computer."

D.   Prior Art Fails to Teach or Suggest the Event Table

Independent claim 1 further recites "an event table comprising the identifications of the plurality of possible states and corresponding events which can occur during the processing of the invoice."

The Examiner cites paragraph 0104 of *Ludwig* as teaching the events table. Office Action, p. 7. This is incorrect.

Paragraph 0104 of *Ludwig* discloses that "the system may generate an automatic e-mail and send it to the selected list of biller system users" "[a]ny time one of these specific events occurs," "[f]or example, . . . invoices loaded successfully, . . . invoice adjusted, payment authorized, payment canceled, payment completed," etc. Although *Ludwig* discloses several events that can occur, *Ludwig* fails to teach or suggest storing these events in an events table in correspondence with a plurality of possible states of the invoice. Therefore, *Ludwig* fails to teach or suggest "an event table comprising the identifications of the plurality of possible states and corresponding events which can occur during the processing of the invoice," as recited in claim 1.

Furthermore, even assuming that *Suzuki* discloses "events which can occur during the processing of the invoice," which Applicants do not concede, *Suzuki* fails to

teach or suggest any table that stores "the identifications of the plurality of possible

states" and the events in correspondence with each other.

Therefore, *Ludwig* and *Suzuki* fail to teach or suggest "an event table comprising

the identifications of the plurality of possible states and corresponding events which can

occur during the processing of the invoice," as recited in claim 1.

E.   Prior Art Fails to Teach or Suggest the Comment Data Field

Independent claim 1 further recites "storing comments entered by the user

through the dialogue in a comment data field corresponding to the invoice in the

electronic data record."

Ludwig is completely silent with respect to any "comments entered by the user

through the dialogue," as recited in claim 1. The Examiner cites paragraph 0064 of

Ludwig as allegedly disclosing "permit[ting] information to be maintained and edited."

Office Action, p. 7. Paragraph 0064 of *Ludwig* discloses that "[t]he system may provide

an 'edit user' option for . . . allow[ing] the administrator to add, modify, or delete users

. . . [and] select an option to edit the active user profile." The "information" that may be

edited "includ[es], e.g., last name, first, middle, phone, fax, e-mail, e-mail2, user id,

password, confirmation, language, currency and privilege group." *Ludwig*, para. 0064.

However, this portion and other portions of *Ludwig* fail to disclose any "comments enter

by the user" and "storing comments . . . in a comment data field . . . in the electronic

data record," as recited in claim 1.

Suzuki is also completely silent with respect any "comments" or "comment data

field," as recited in claim 1. Also, the Examiner does not rely on *Suzuki* for these claim

elements. Therefore, *Ludwig* and *Suzuki* fail to teach or suggest "storing comments entered by the user through the dialogue in a comment data field corresponding to the invoice in the electronic data record," as recited in claim 1.

For at least the foregoing reasons, the scope and content of the prior art have not been properly determined, and the differences between the prior art and claim 1 have not been properly ascertained. Moreover, the Examiner has not identified any factors that would motivate one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combination. Accordingly, no reason has been clearly articulated as to why the prior art would have rendered claim 1 obvious to one of ordinary skill in the art. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1.

Independent claims 8, 14, and 20, although different in scope from claim 1, are allowable for at least reasons similar to those presented above with respect to claim 1. Dependent claims 6, 10, 12, 13, 16, 18, 19, 22, 24, 25, 28, and 29 are allowable at least due to their dependence from an allowable independent claim. Claims 5 and 7 have been canceled, rendering the rejection thereof moot. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 6, 8, 10, 12-14, 16, 18-20, 22, 24, 25, 28, and 29 under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: August 4, 2009   By:_____

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